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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,211	10/23/2001	Arnold W. Fogel	B30-050	2238

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EXAMINER

HUI, SAN MING R

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/045,211

Applicant(s)

FOGEL, ARNOLD W.

Examiner

San-ming Hui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation "'actives" and medicaments", and the claim also recites "vitamins, among numerous additional additives" which is the narrower statement of the range/limitation. Moreover,

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claim 8 recites the broad recitation "anti-perspirant compounds", and the claim also recites "salts, among others" which is the narrower statement of the range/limitation.

The expression "water-soluble actives and medicaments" in claims 8 and 25 renders the claims indefinite as to the compounds encompassed by the claims.

The expressions "among numerous additional additives" and "including salts, among others" in claim 8 render the claims indefinite as to the compounds encompassed by the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fogel (US Patent 6,126,949 from the IDS received June 11, 2002), Herstein (US Patent

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5,902,591), and McCutcheon (McCutcheon's Emulsifiers & Detergents North American Edition, 2000, 2000, page 18).

Fogel teaches the instant component A, a dialkyl fumarate, especially dibehenyl fumarate, is useful in harden or stiffen any cosmetically acceptable oil or water-in-oil emulsions and to enhance the stability of water-in-oil emulsion (See particularly the abstract). Fogel also teaches the emollients may be used with dibehenyl fumarate as petrolatum, mineral oil, various vegetable oils such as sunflower oil and safflower oil, and neopentanoates such as octyl dodecyl neopentanoate (See col. 3, line 65 - col. 4, line 59; also col. 10, line 64 in example 5). Fogel also teaches that the water-in-oil emulsion may contain 20-25% to 55-60% of water and 40-45% to 75-80% of emollient oil (See col. 5, line 31-33). Fogel also teaches that nonionic emulsifiers may be used in the water-in-oil emulsion (See col. 6, line 25).

Herstein teaches that a 5-10% of vitamin C containing topical cosmetic composition employing several preferred emulsifiers: one of which is stearic monoethanolamide (the instant preferred component C) (See the abstract and also col. 5, line 23).

McCutcheon teaches the Arlacel P135, the instant preferred component B, is useful as an emulsifier for cosmetic use (See page 18, col. 2).

The references do not expressly teach the three components can be incorporated into a single composition. The references do not expressly teach the specific weight ratio of the three components as 1-15% of component A, 1-15% of component B; and the ratio among components A, B, and C as 1:1:1 or 3:2:3.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the three components herein into a single composition in the weight ratio herein.

One of ordinary skill in the art would have been motivated to incorporate the three components herein into a single composition in the weight ratio herein because component B and C are known, based on the cited prior art, to be useful as emulsifiers in water-in-oil emulsion. Combining two agents, which are known to be useful as emulsifiers individually into a single composition useful for formulating an emulsion composition, is *prima facie* obvious. See *In re Kerkhoven* 205 USPQ 1069. Moreover, dibehenyl fumarate, component A, is known to be useful to enhance the stability of water-in-oil emulsion. Therefore, further incorporating component A into the emulsion composition containing component B and C would have been reasonably expected to be useful in stabilizing the resulting emulsion composition. In addition, the optimization of result effect parameters (e.g., weight ratio or amount of the components) is obvious as being within the skill of the artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Travers, J.D., can be reached on (703) 308-4603. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui  
August 26, 2002

RUSSELL TRAYERS  
PRIMARY EXAMINER  
GROUP 1200